

REMARKS

This response to the Office Action is part of the Request for Continued Examination. Claims 1-16, 18-32 are pending, with claims 1, 20, and 32 being independent. Claim 17 has been cancelled. New claim 33 has been added. No new matter has been added.

Hirota in view of Ginter Rejection

Claims 1-16 and 18-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hirota (6,606,707) in view of Ginter (US 5,892,900).

As presented, claim 1 recites among other features, "configuring the media player to access a permissions engine that interfaces with a multitiered rule base that is configured to store a medium rule base, a media player rule base, and a host rule base, wherein the medium rule base is based on content permissions associated with the medium, the media player rule base is based on content permissions associated with the media player, and the host rule base is based on content permissions associated with the host."

Hirota does not teach or suggest the above features. Specifically, Hirota fails to teach a medium rule base and a host rule base. Hirota also does not teach a multitiered rule base that is configured to store a medium rule base, a media player rule base, and a host rule base.

The Office Action points to Col. 15:10-15 and 55-62 in Hirota as allegedly showing a media player rule base. See Office Action, page 3. That section of Hirota describes a master key 323a being stored on the player. Applicants submit that the master key 323 is not a rule base of any form. Hirota repeatedly describes master key 323 as a key used for encryption/decryption of data. See e.g., Col. 11:23-27, Col. 14:61-64, Col. 15:20-25.

In contrast, the media player rule base is not a simple encryption/decryption key, but rather a set of rules associated with content permissions for the media player. For instance, the application provides one example of a rule base on page 23, line 25- page 24, line 5:

The media player rule base may include a set of rules that are associated with or stored on the media player. The media player rule base may receive a content request and analyze the request against a stored set of permissions. The media player rule base may provide selective access to the media player. For example, the media player rule base may manage licenses for content that is purchased for installation on a particular media player.

The media player rule base also may relate to a particular user identity. For example, a user may be participating in a purchasing program where the content is distributed and accessible by a particular user. When

other users attempt to access the content, the access rights may be reduced or eliminated. Thus, when using the multitiered rule base to analyze the content request, the media player 901 may identify the user. The user may be identified by enabling input of a user profile (e.g., by using an out-of-band token), or by associating the media player 901 with a particular identity (e.g., by analyzing the user's phone number or network information that is used when accessing a host).

Therefore, it is clear that a "media player rule base" cannot be the master key 323 because the master key 323 is not a rule base – rather, the master key 323 is merely a key used by the media player in conjunction with media ID 341 to encrypt or decrypt data. The master key 323 by itself does not specify any rules for content permissions associated with the media player.

The Office Action also points to the encryption key 425 described in Col. 15:15-20 as allegedly showing a host rule base. See Office Action, page 3. First, it is not clear how the encryption key 425 is "is based on content permissions associated with the host," as required by claim 1. It appears that encryption key is read out from the card 109 and not obtained from the host. See Col. 15:15-20. Second, the encryption key 425 is not a host rule base. As explained above, an encryption key by itself does not specify any rules for content permissions associated with the host.

In contrast, the host rule base is not a simple encryption key, but rather a set of rules associated with content permissions for the host. For instance, Application provides one example on page 24, line 8-15:

The host rule base also may be used in analyzing the content request. A media player 901 with a communications interface may exchange information with a host 902 to analyze the content request. In one example, the host 902 receives information from the media player 901 to evaluate the transaction. The host 902 then may decide whether to allow the media player 901 to engage in the content request. In another example, the host 902 may provide information to the media player 901 so that the media player 901 may decide whether to allow the content request.

Therefore, as explained with respect to the media rule base above, the host rules base also cannot be a simple encryption key.

Moreover, Hirota does not teach or suggest a multitiered rule base that is configured to store a medium rule base, a media player rule base, and a host rule base. The Office Action does not point to a specific section in Hirota that describes this element.

For these reasons, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of amended independent claim 1 and its respective dependent claims.

Similarly, independent claims 20 and 32 recite an arrangement for regulating access to a content selection that is similar to that recited in amended claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claims 20 and 32 and their respective dependent claims for the reasons discussed above with respect to amended independent claim 1.

New claim 33 is also believed to be allowable for the reasons explained above with respect to claim 1.

Claims 9-14, 18, 19, 24-31

Citing MPEP § 2106 Section II(C), the Office action stated that claims 9-14, 18, 19, and 24-31 include optional limitations, and read these limitations out of the claims. The Applicants respectfully disagree.

Specifically, MPEP § 2106 Section II(C) recites, "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of intended use or field of use, (B) "adapted to" or "adapted for" clauses, (C) "wherein" clauses, or (D) "whereby" clauses. See also MPEP § 2111.04."

MPEP § 2111.04. applies case law indicating, "that when a 'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention", (Hoffer v. Microsoft Corp., 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), and "that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited", (quoting Minton v. Nat'l Ass'n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614 (Fed. Cir. 2003)).

In this case, Applicants' claim language should not be considered optional, as it does not include statements of intended use or field of use, "adapted to" or "adapted for" clauses, "wherein" clauses, or "whereby" clauses, nor does it simply express the intended result of a process step positively recited. Rather, Applicants' claim language states a condition that is material to patentability, and thus, it cannot be ignored, as ignoring the same would clearly constitute a change to the substance of the invention. More specifically, within the Applicants'

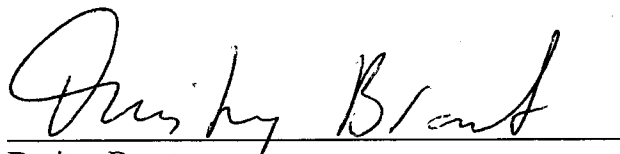
method, as one of the steps is conditional, and not optional, the conditional step must be considered part of the whole claimed method.

Applicants note that MPEP § 2106 Section II(C) further recites, "when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discreet elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." Diamond v. Diehr, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981). Therefore, in dissecting the claimed invention and evaluating the elements in isolation, the Office Action has clearly not considered the claim as a whole. Thus, the Applicants respectfully request reconsideration of claims 9-14, 18, 19, 24-31, as they do not in fact contain optionally recited limitations, and therefore should be considered in their entirety for purposes of determining patentability.

The \$1520 fee (\$220 for excess independent claim; \$490 for two-month extension of time; and \$810 for Request for Continued Examination) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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